



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,004	01/24/2002	Kenneth J Breslauer	RU-0124	6792

26259 7590 08/20/2003  
LICATLA & TYRRELL P.C.  
66 E. MAIN STREET  
MARLTON, NJ 08053

EXAMINER
TUNG, JOYCE

ART UNIT	PAPER NUMBER
1637	10

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	Application No. <b>09/869,004</b>	Applicant(s) <b>Breslauer et al.</b>
	Examiner <b>Joyce Tung</b>	Art Unit <b>1637</b>
		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jul 24, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

a)  The period for reply expires 3 months from the mailing date of the final rejection.

b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_ . Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.  The proposed amendment(s) will not be entered because:

- they raise new issues that would require further consideration and/or search (see NOTE below);
- they raise the issue of new matter (see NOTE below);
- they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3.  Applicant's reply has overcome the following rejection(s):  
\_\_\_\_\_

4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.  The a)  affidavit, b)  exhibit, or c)  request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
please see the attached.

6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.  For purposes of Appeal, the proposed amendment(s) a)  will not be entered or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: 17, 20, 21, 23 and 24

Claim(s) rejected: claims 1-17, 19, 22, 25-32, and 38-45

Claim(s) withdrawn from consideration: \_\_\_\_\_

8.  The proposed drawing correction filed on \_\_\_\_\_ is a)  approved or b)  disapproved by the Examiner.

9.  Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14

10. Other:

Art Unit: 1637

The amendment filed 7/24/2003 has been not entered. Claims 1-45 are pending.

1. The limitations of the newly added claims 46-49 raise new issues that would require further consideration and/or search because the limitations of original claim 1 are drawn to a method for screening for nucleic acid duplex stability by competitive equilibria comprising producing a known amount of an initial nucleic acid duplex with known stability in a solution, titrating the solution with a known concentration of the target nucleic acid strand in a second solution which competes with the first nucleic acid strand of the initial nucleic acid duplex and monitoring the titration solution for changes in the amount of initial nucleic acid duplex formed as a function of the amount of target nucleic acid strand added, while the limitations of the newly added claims 46-49 are drawn to a method of screening for nucleic acid duplex stability comprising the measuring changes in FET donor or acceptor intensity of a nucleic acid duplex. Thus, they are not the same inventions.

2. Rejections and/or objected from the previous office action are maintained with the same reasons as set forth in the Office action mailed 4/24/2003. They are reiterated herein.

3. Claims 1-15 and 30-32 remain rejected under 35 U.S.C. §103(a) as being unpatentable over Albrecht et al. (6,265,163) in view of Drmanac et al. (5,525,464) and Breslauer et al. (Proc. Natl. Acad. Sci USA, 1988, Vol. 83, pg. 3748-3750).

4. Claims 16-17, 19, 22, 25-28, and 39-45 are also rejected under 35 U.S.C. §103(a) as being unpatentable over Albrecht et al. (6,265,163) in view of Drmanac et al. (5,525,464) and Breslauer et al. (Proc. Natl. Acad. Sci USA, 1988, Vol. 83, pg. 3748-3750).

Art Unit: 1637

5. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Albrecht et al. (6,265,163) in view of Drmanac et al. (5,525,464) and Breslauer et al. (Proc. Natl. Acad. Sci USA, 1988, Vol. 83, pg. 3748-3750) as applied to claims 1-17, 19, 22, 25-28, 30-32 and 39-45 above, and further in view of Malmqvist (5,972,612).

6. Claim 38 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 38 is vague and indefinite because claim 4 depends from claim 1 which is a method of screening for nucleic acid duplex stability by competitive equilibria, while claim 38 recites a method for extraction enthalpy data. It is unclear whether the method of claim 1 further includes the step for extracting enthalpy data. Clarification is required.

7. Claims 18, 20-21 and 23-24 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. No claims are allowable.

9. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

Art Unit: 1637

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

10. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

  
J.T.  
July 31, 203

**ETHAN WHISENANT**  
**PRIMARY EXAMINER**